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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,357	06/19/2001	Lothar K. Faber	A7694	9655

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EXAMINER

NGUYEN, THONG Q

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 09/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,357

Applicant(s)

FABER, LOTHAR K.

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 2-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 02 July 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the Amendment (Paper No. 7) filed on 7/2/2002.
2. It is noted that in the amendment filed on 7/2/2002, applicant has made amendments to the original claim 1 and simultaneously added a new set of claims, i.e., claims ²⁻⁶2-6, into the present application.

As amended and newly-added, the pending claims 1-6 are subjected to the following restriction requirement.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 2 and 5, drawn to a microscope having means (B) for viewing samples in one of three dimensions, two dimensions and macro; and means (A) for sorting the samples and for verifying details of the samples. In other words, the claims direct to an AB structure, classified in class 359, subclass 385.
- II. Claim 1, drawn to a microscope having a system (B) for viewing samples wherein the system comprises an objective carrier with automatic shift for carrying a stereo objective and a compound objective, classified in class 359, subclass 381.
- III. Claims 3-4 and 6, drawn to a microscope having means (B) for viewing samples in one of three dimensions, two dimensions and

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macro wherein the means comprises a stereoscopic objective and two compound objectives; and means (A) for sorting the samples and for verifying details of the samples. In other words, the claims direct to an AB structure, classified in class 359, subclass 368.

4. The inventions are distinct, each from the other because of the following reasons:

Inventions I and (II,III) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the omission of details of the claimed subcombination in the combination is evidence that the patentability of the combination does not rely on the details of the specific combination. The subcombination has separate utility for use in a microscope without the means for sorting samples and for verifying detail of the samples as recited in the combination.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 2-6 have been

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withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Oath/Declaration

7. The objection to the oath or declaration is now withdrawn by the filing of a new Oath/Declaration which complies with the requirements.

Drawings

8. The corrected or substitute drawings were received on 7/2/2002. These drawings are approved by the Examiner. However, the clean version of the drawings is objected to because of the following reasons: First, in figure 2, the term "M" and in fig. 5, the description appeared at the bottom of figure which both are deleted in the corrected drawings; however, the mentioned items still shown in the clean version of figures 2 and 5.

Specification

9. The lengthy specification which is amended by the Amendment has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama et al (U.S. Patent No. 6,226,118) in view of Spitznas et al (U.S. Patent No. 4,710,000) (both of record).

Koyama et al disclose a fluorescent microscope having illuminating systems for providing transmitting light and/or reflecting light to a fluorescent sample. In their microscope, they teach the use of a mechanism supporting a plurality of filtering sets each comprises a dichroic mirror, an exciting filter and a barrier filter (see column 9 and figs. 5-7) and each is able to select to insert into the optical path of the microscope over a selected objective lens system; and a revolver for supporting at least two objective lens systems (21, 22 or 81,82) wherein each objective lens is able to select to enter into the optical path (see columns 7-8 and figs. 1, 4 and 19, for example) for providing a desired illumination and observation. While the objective lens systems used by Koyama et al are not clearly defined as stereo and/or compound lens systems as recited in the present claim; however, it is noted that the present claim does not provide any specific limitations/features of the so-called "stereo lens" and "compound lens" used in the claim; and it would have been obvious to one skilled in the art at the time the invention was made to use a revolver for supporting any kind of suitable objective lens systems in the market or known in the art in the system provided by Koyama et al for the purpose of selecting a particular set of objective lens system in the optical path for meeting a desired illumination/observation. As a result of the structure of the microscope described in columns 7-10, the only feature missing from the art of Koyama et al is that it does not clearly state that the microscope is a binocular or stereoscopic microscope

by using a prism shift mechanism for providing binocular images from the light passing through the selected objective lens system. However, one skilled in the art as can be seen in the stereoscopic microscope provided by Spitznas et al knows the use of a set of prism elements in a microscope for the purpose of providing binocular or stereoscopic images to a user. In particular, at columns 3-4 and figure 9, Spitznas et al disclose the use of a set of prism systems (20 and 24) wherein one of prism system is selectively chosen to be placed into the light path for providing either a stereoscope observation or a normal observation. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the microscope provided by Koyama et al by using a set of prism systems as suggested by Spitznas et al wherein a particular prism system is selectively chosen to enter into the light path for providing a desired observation.

Response to Arguments

12. Applicant's arguments filed on 7/2/2002 have been fully considered but they are not persuasive.

First, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., two or three dimensions, means for sort, pick, or manipulate samples, etc...) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not

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read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, as clearly stated in the rejection of the claims, the claim refers to some kind of objectives such as stereo objective and compound objective; however, it is noted that the present claim does not provide any specific limitations/features of the so-called "stereo lens" and "compound lens" used in the claim. In other words, a stereo objective can be understood as an objective for use in a stereoscopic microscope which comprises different prisms for providing a stereoscopic image to an observer, and a compound objective can be understood as a set of objective arranged in serial to each other. With such an interpreter then the use of different objectives as provided by Koyama meets the features concerning the objectives claimed.

Third, in regard to applicant's arguments concerning the art of Spitznas, such arguments are not persuasive because Spitznas art is used in the rejection for the purpose of showing one skilled in the art the use of a set of prism elements in a microscope for the purpose of providing binocular or stereoscopic images to a user.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory

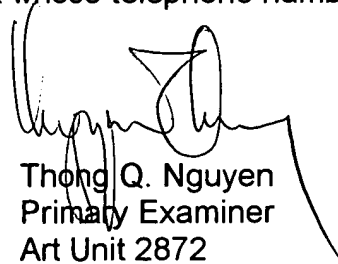
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action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is 703 308 4814. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on 703 308 1687. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 7724 for regular communications and 703 308 7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen
Primary Examiner
Art Unit 2872

September 18, 2002